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In re Application of:
KOBATA, Hiroshi, et al.
U.S. Application No.: 10/550,574
PCT No.: PCT/JP2004/004278
International Filing Date: 26 March 2004
Priority Date: 26 March 2003
Atty's Docket No.: 470223.00067
For: CONTROL DEVICE FOR HYDAULIC CYLINDER

DECISION ON PETITION

This decision is issued in response to applicants' "Petition To Accept A Patent Application Made By Other Inventors On Behalf Of Non-Signing Inventor" filed 22 September 2005. No petition fee is due.

BACKGROUND

On 26 March 2004, applicants filed international application PCT/JP2004/004278. The international application claimed a priority date of 26 March 2003, and it designated the United States. On 07 October 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 26 September 2005.

The published international application identified two applicant/inventors for the United States: Hiroshi KOBATA and Christopher John KOLBE.

On 22 September 2005, applicant filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a translation of the international application into English, and the petition considered herein. The petition requests acceptance of the application under 37 CFR 1.47(a) without the signature of purported inventor Rollin C. CHRISTIANSON, whom applicants assert has refused to execute the declaration.

DISCUSSION

The applicant/inventors of record in the present application are Hiroshi KOBATA and Christopher John KOLBE, as set forth on the published international application. The declaration materials submitted with the present petition include a third inventor, Rollin C.

CHRISTIANSON. It is this additional inventor who has purportedly refused to execute the declaration and who is the subject of the 37 CFR 1.47(a) petition submitted herein.

Where, as here, the filed declaration names additional inventors who were not identified on the international application, 37 CFR 1.497(d) requires applicant to submit: (1) a statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b)). Applicants here have not satisfied the requirements of 37 CFR 1.497(d) with respect to Rollin C. CHRISTIANSON. Mr. CHRISTIANSON is therefore not an inventor of record in the present application.

Based on the above, applicants' present petition under 37 CFR 1.47(a) seeking acceptance of the declaration without the signature of Rollin C. CHRISTIANSON is dismissed as moot. Applicants will not be charged the $200 petition fee.

It is noted that the addition of Mr. CHRISTIANSON as an inventor of record herein would require a statement from this inventor pursuant to 37 CFR 1.497(d)(1). This might be problematic, given that applicants are asserting that Mr. CHRISTIANSON has refused to execute application papers in the present case. In the analogous context of a petition under 37 CFR 1.48, section 201.03(II)(A) of the MPEP addresses situations where the required statement from an added inventor cannot be obtained. The MPEP states that, on "very infrequent occasions," the statement requirement can be waived pursuant to a petition under 37 CFR 1.183. The MPEP goes on to suggest an alternative remedy, as follows:

> An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole-to-sole correction would not obtain benefit under 35 U.S.C. 120).

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT** because the inventor who is the subject of the petition is not an inventor of record in the present application.

The declaration filed 22 September 2005 is defective for failure to properly identify the inventors of record herein (the declaration also appears to be an unacceptable compilation of multiple declarations).

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

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